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TELEFAX COVER SHEET

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Please deliver the following (4) page(s) (including this cover page) to:

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Company: U.S. PATENT AND TRADEMARK OFFICE

Re: Serial No.: 09/812,980
(Our Ref. No. 2080-3-09)

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Message: Per our conversation on January 6, 2004, please find attached a synopsis of the issues I wish to discuss in the telephonic interview scheduled on January 13, 2004 at 2:00 PM EST.

From: Richard C. Salfelder, Esq.

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§ 102 Rejection

Claims 1-16, 18 and 19 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nagasato (US 6,181,670). The portions of Nagasato et al. cited by the Examiner in the Office action appear to have been misinterpreted. I wish to discuss the following:

Independent claim 1 recites an actuator having both a lens holder having a magnet and coils mounted thereon and a fixed body having a magnet and coils mounted thereon.

The Examiner asserts on page 4 of the Office action that Nagasato col. 8, ll. 22-34 and Figure 1 discloses all the elements of claim 1.

However, Nagasato, at col. 8, ll. 59-68, discloses that coil assemblies 112 and 114 each have "a focusing coil, a tracking coil, a radial tilt coil and a tangential tilt coil" and, at col. 9, ll. 30-42, discloses that "driving coil assemblies 112 and 114 are connected to the support block."

Therefore all the coils are mounted to the fixed body (support block). The portion of Nagasato cited by the Examiner does not disclose a lens holder having any coils.

Nowhere else in Nagasato is an actuator disclosed having both a lens holder having a magnet and coils mounted thereon and a fixed body having a magnet and coils mounted thereon.

Independent claims 9, 12, 15 and 20 all recite an actuator having a combination of a moving magnet system and a moving coil system.

The Examiner asserts, on page 4 of the Office action, that the combination of Nagasato col. 11, line 45 through col. 12, line 40 and Figure 7 and col. 16, ll. 6-47 and Figure 22 disclose the combination of a moving magnet system and a moving coil system of claims 9 and 12.

However, Nagasato at col. 12, ll. 36-37, discloses that the objective lens driving device 101 in the second embodiment (Figure 7) "is of a moving magnet type" and, at col. 16, ll. 44-45, discloses that the objective lens driving device in the sixth embodiment (Figure 22) "is of a moving coil type." Neither of these embodiments discloses the combination of a moving magnet system and a moving coil system.

The Examiner is combining two separate embodiments disclosed in Nagasato for which there is no motivation to combine.

The Examiner asserts on page 6 of the Office action that parts 11a-d, 12a, 12b, 5a-d and 13a-d of Nagasato Figure 7 and parts 23a-d, 24a, 24b and 25a-f of Nagasato Figure 22 disclose the combination of a moving magnet system and a moving coil system of claim 15.

See previous comments regarding the moving magnet system of Figure 7 and the moving coil system of Figure 22.

The Examiner is again combining two separate embodiments disclosed in Nagasato for which there is no motivation to combine.

§ 103 Rejection

Claim 20 was rejected under 35 U.S.C. § 103(a) as being obvious over Nagasato in view of Gijzen (US 4,767,187). I am a bit confused by the rejection in light of the Examiner's assertions with regard to the 102 rejections. I wish to discuss the following:

Independent claim 20, as does Independent claim 1, recites an actuator having both a lens holder having a magnet and coils mounted thereon and a fixed body having a magnet and coils mounted thereon.

The previous remarks with respect to Nagasato not disclosing this limitation are applicable here. Since the Examiner does not assert that Gijzen discloses this limitation, independent claim 20 is allowable for the same reasons that independent claim 1 is allowable.

Independent claim 20, similar to independent claims 9, 12 and 15, also recites an actuator having a combination of a moving magnet system and a moving coil system.

The Examiner asserts, at paragraph 10 of the Office action, that Gijzen 'discloses "combination of a moving coil system and a moving magnet system (see column 6, lines 28-36)' that Nagasato fails to disclose. This seems to be in agreement with my previous remarks and in contrast to the Examiner's assertions on page 5 of the Office action that Nagasato discloses this limitation.

Furthermore, neither Nagasato nor Gijzen provides the requisite motivation to modify the Nagasato invention with the teachings of Gijzen.

Nagasato, as is the present invention, is directed to a quadaxially driving device that provides tracking and focusing operations as well a tilt compensating operations.

Gijzen, as disclosed at col. 2, ll. 46-57, is directed to "a 2D actuator" that provides "[movement] along the pivotal axis for the focusing movements" and "[movement] about the

pivotal axis for the purpose of radial or tangential tracking." The "radial and tangential tracking" disclosed in Gijzen is the radial and tangential tilt operation disclosed in Nagasato and the present invention.

No tracking operation such as that disclosed in Nagasato and the present invention is disclosed. Furthermore, Gijzen, at col. 5, ll. 9-14, discloses that radial tracking is performed by "a slide of the optical disc player" rather than the actuator.

Therefore, there is no motivation to modify the quadaxially-driving device of Nagasato with the biaxially-driving actuator of Gijzen to attain the quadaxially-driving device of the present invention.

Even if the requisite motivation is found to modify Nagasato with the teachings of Gijzen, the Examiner's assertion that "Gijzen et al. teaches 'replacing "one magnet" of the frame with "one coil" and replacing "one coil" of the optical holder with "one magnet" is traversed.

Gijzen discloses, at col. 4, ll. 59-63 and col. 5, ll. 22-30, an optical holder 10 having focusing coil 14 and tracking coil 24 and magnets 16, 20 secured to the deck plate 2A1. There are no magnets disclosed as being on the optical holder 10, nor are any coils disclosed as being secured to the deck plate 2A1.

The portion of Gijzen et al. to which the Examiner refers (col. 6, ll. 28-36) states that "it is possible to replace one or more magnets of the frame by one or more suitable coils...in combination with **the replacement of the coils** of the optical holder by magnets." Note that the replacement of "*one or more coils* of the optical holder by magnets" is not disclosed, but rather the *replacement of all the coils*.

It is respectfully asserted that the "replacement" suggested at col. 6, ll. 28-36 of Gijzen would still result in the optical holder 10 having *only* magnets. Therefore, the "replacement" would simply convert a moving coil system to a moving magnet system, not create a combination of a moving magnet system and a moving coil system